UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,471	02/01/2002	Jerry S. Brown	83635	5963

7590 10/01/2004

James B. Bechtel
Office of Counsel (Patents) Code XDC1
Naval Surface Warfare Center
Dahlgren Division
Dahlgren, VA 22448-5100

EXAMINER	
ANTHONY, JOSEPH DAVID	
ART UNIT	PAPER NUMBER
1714	

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/057,471	BROWN, JERRY S.
	Examiner	Art Unit
	Joseph D. Anthony	1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *09/13/04 as RCE and Preliminary-Amend.*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *14-16 and 19-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *14-16 and 19-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 14-16 and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 14 is indefinite in regards to the listed molar ratio. Is the molar ratio the molar ratio between the peroxygen compound and the bleach activator, **or** is it the molar ratio between (peroxygen compound + bleach activator) and the surfactant composition?

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over Sanderson U.S. Patent Number 4,541,944.

Applicant's claims are deemed to be anticipated over Sanderson's '944, see the examples, such as examples 8, 11-20, 31-34 and 42-43 and column 16, lines 33-40. Also see column 17, line 64 to column 18, line 8.

In the alternative, applicant's claims are deemed to be obvious over said patent in that it is unclear if it directly teaches (i.e. by way of an example) applicant's particular claimed molar ratio of peroxygen compound to bleach activator. It is deemed that even if the examples of the said patent do not directly teach said ratio, the individual broad disclosure of said patent is deemed to strongly suggest such a molar ratio.

6. Claims 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over Del Duca et al U.S. Patent Numbers (5,968,885 or 6,071,870).

Applicant's claims are deemed to be anticipated over Del Duca et al "885,

see examples V-VII. Also see column 11, line 62 to column 12, line 4.

Applicant's claims are deemed to be anticipated over Del duca et al .870, see examples VIII-XI. Also see the abstract and column 10 and column 15. Also see column 11, lines 32-41.

In the alternative, applicant's claims are deemed to be obvious over said patents in that it is unclear if they directly teach (i.e. by way of an example) applicant's particular claimed molar ratio of peroxygen compound to bleach activator. It is deemed that even if the examples of the said patents do not directly teach said ratio, the individual broad disclosure of each patent is deemed to strongly suggest such a molar ratio.

7. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanderson U.S. Patent Number 4,541,944 or Del Duca et al U.S. Patent Numbers (5,968,885 or 6,071,870). These patents have been described above and differs from applicant's claimed composition in that the references do not directly teach (i.e. by way of an example) compositions that contains applicant's specifically claimed component species. It would have been obvious to one having ordinary skill in the art to use the broad disclosure of the references as motivation to actually use applicant's claimed component species since such species are deemed to fall within the broad disclosure of solvents, surfactants, pH adjusting regulators (e.g. buffer), bleach components, and bleach activators, as set forth by the references.

8. Claims 14-16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Scheuing et al. U.S. Patent Numbers 5,681,805 or 5,792,385.

Applicant's claims are deemed to be anticipated over Scheuing et al's '385 Examples 9-11. Also see column 13, lines 29-42.

Applicant's claims are deemed to be anticipated over Scheuing et al's '805 Examples 13-14. Also see claims 24-38.

In the alternative, applicant's claims are deemed to be obvious over the Scheuing et al patents in that it is unclear if they directly teach (i.e. by way of an example) applicant's particular claimed molar ratio of peroxygen compound to bleach activator. It is deemed that even if the examples of the said patents do not directly teach said ratio, the individual broad disclosure of each patent is deemed to strongly suggest such a molar ratio

9. Claims 14-16 are rejected under 35 U.S.C. 102(e) as being anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over Zhou et al. U.S. Patent Number 5,877,137 or Kott et al. U.S. Patent Number 6, 117,357 or Miracle et al. U.S. Patent Number 6,096,098.

Applicant's claims are deemed to be anticipated over Zhou et al's examples. Also see claims 1-14.

Applicant's claims are deemed to be anticipated over Kott et al's examples, such as example XI. Also see claims 6-7.

Applicant's Claims are deemed to be anticipated over Miracle et al's examples, such as example IX. Also see claims 22-23.

In the alternative, applicant's claims are deemed to be obvious over said patents in that it is unclear if they directly teach (i.e. by way of an example) applicant's particular claimed molar ratio of peroxygen compound to bleach activator. It is deemed that even if the examples of the said patents do not directly teach said ratio, the individual broad disclosure of each patent is deemed to strongly suggest such a molar ratio.

10. Claims 14-15 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Scialla et al. U.S. Patent Numbers (6,099,587 or 5,997,585 or 5,900,187)

Applicant's claims are deemed to be anticipated over Formulations I-III and the claims of '587, over the examples and claim 1 of '585, and over the examples and column 2, lines 1-10 of 1187.

In the alternative, applicant's claims are deemed to be obvious over said patents in that it is unclear if they directly teach (i.e. by way of an example) applicant's particular claimed molar ratio of peroxygen compound to bleach activator. It is deemed that even if the examples of the said patents do not directly teach said ratio, the individual broad disclosure of each patent is deemed to strongly suggest such a molar ratio.

11. Claims 14 and 16 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Choy et al. U.S. Patent Number 6,010,994.

Applicant's said claims are deemed to be anticipated over examples 3 and 5.

In the alternative, applicant's claims are deemed to be obvious over said patent in that it is unclear if it directly teaches (i.e. by way of an example) applicant's particular claimed molar ratio of peroxygen compound to bleach activator. It is deemed that even if the examples of the said patent do not directly teach said ratio, the individual broad disclosure of said patent is deemed to strongly suggest such a molar ratio.

12. Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheuing et al. U.S. Patent Numbers (5,792,385 or 5,681,805) or Scialla et al. U.S. Patent Numbers (6,099,587 or 5,997,585 or 5,900, 187) or Kott et al. U.S. Patent Number 6,117,357 or Miracle et al. U.S. Patent Number 6,096,098.

The two Scheuing et al patents, the three Scialla et al patents, the Kott et al patent, and the Miracle et al patent, have been described above and differ from applicant's claimed composition in that the following ways: 1) there is no direct teaching (i.e. by way of an example) to where a peroxycarboxylic acid compositions is produced by the reaction product of the peroxygen compound and bleach activator, and 2) the reference does not directly teach (i.e. by way of an example) a compositions that contains applicant's specifically claimed Component species, such as a buffer.

It would have been obvious to one having ordinary skill in the art to use the individual broad disclosures of the references as motivation to actually react the peroxygen compound with the bleach activator to make a peroxycarboxylic acid composition since such a reaction is the intended purpose the of taught compositions.

It would also have been obvious to one having ordinary skill in the art to use the individual broad disclosures of the references as motivation to actually use applicant's claimed component species, such as a buffer or pH control agent, since such species/components are deemed to fall within the broad disclosure of solvents, surfactants, bleach components, buffers, and bleach activators, as set forth by the individual references.

Response to Arguments

13. Applicant's arguments filed 09/13/2004 with the Preliminary Amendment and RCE have been fully considered but are not persuasive to put the application in condition for allowance for the reasons set forth above. Additional examiner comments are set forth below.

Applicant's amendment to independent claim 14 inserting: "a decontaminating composition consisting essentially of" in line 3 of the claim, ***is not*** considered to be indefinite, but is nevertheless not deemed to really further limit the scope of the claim since such a limitation is already present in the claim in line 2.

Applicant's main argument for patentability of the pending claims continues to be that wherein applicant's claimed invention is directed towards a chemical and biological warfare decontamination solution, the applied prior art solutions are directed to other intended uses, such as washing, bleaching, cleaning, and/or disinfecting. This argument of applicant, even if true, is irrelevant to the patentability of the pending claims. Applicant is reminded that many of applicant's claims are rejected as being anticipated over the solutions taught by the applied prior-art references. It is thus irrelevant what the prior-art intended use is for their taught solutions since they directly anticipate applicant's claimed solutions. Furthermore, the courts have ruled numerous times that a novel intended use for an otherwise old or obvious composition does not render said composition patentably. Applicant claims are drawn to a solution and not to a method of use. If applicant's claims were drawn to a method of use then the disclosure of the applied prior-art patents in regards to their intended use would indeed be relevant.

In applicant's remarks on pages 7-8 of the preliminary amendment filed 09/13/04, applicant argues that decontamination solutions for chemical and biological warfare agents operate far better within an alkaline pH range instead of an acidic pH range. Applicant then argues that example IX of U.S. Patent Number 6,096,098 to Miracle et al teaches peroxide + activator bleaching formulations that have a pH of 4. While it is true that Miracle et al's example IX does have a pH of 4, many of Miracle's other examples have a different PH,

which can be alkaline. Furthermore, applicant's attention is drawn to column 29, lines 39-45 wherein Miracle et al states: *"Liquid compositions according to the present invention may be formulated* ***acidic to deliver an in-use alkaline pH****. Low pH formulation is generally from about 2 to about 5 and preferably from about 2.5 to 4.5.* ***In-use pH is may range from about 7 to about 11, preferably from about 9.5 to about 10.5****"*. [Emphasis added]. Miracle et al. thus does not teach away from applicant's argued but not claimed alkaline pH, but rather teaches that an alkaline pH is the In-use pH of their taught peroxy + activator compositions. In any case, applicant's pending claims do not have any pH limitation or range.

Examiner Information

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (703) 872-9306. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.

Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714

9/27/04